

### Remarks

Claims 1 through 19 and 36 through 54 were pending in the application. Claims 1, 3, 9, 11 through 13, 18, and 53 have been amended by the amendments presented herein. Claims 36 through 44 have been canceled as being directed to non-elected inventions.

In the Office Action, the Examiner objects to claims 1 through 19 and 45 through 54 and has rejected claims 1 through 19 and 45 through 54. No new matter has been added by the amendments presented herein.

### Claim Objections

Claims 1 through 19 and 45 through 54 have not been amended to limit them to the elected species. The Applicants traverse the 35 USC 112 rejections as discussed herein, respectfully request withdrawal of the rejections, and request the nonelected subject matter be rejoined.

The claims containing “alkoxy” for variables R<sup>5</sup> and R<sup>6</sup> have been amended to more clearly define the substituants. Also, claim 3 has been amended to state “according.”

### Claim Rejections

#### 1. 35 USC 112, First Paragraph, Written Description Rejection of Claims 1-19 and 45-54

Claims 1-19 and 45-54 are rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. As grounds for rejection, it is stated that the disclosure supports only compounds reduced to practice to support the definitions for R<sup>3</sup> and R<sup>4</sup> joined to form piperidine, piperazine, pyrrolidine or morpholine (all optionally substituted with alkyl or benzyl). It is stated the specification fails to provide adequate written description for the genus of compounds claimed and does not reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed, had possession of the entire scope of the claimed invention. Also, it is stated that the specification fails to provide adequate written

description to support (ii) claim 17 amorphous or crystalline forms of the compounds in section (i), and (iii) claim 19 solvents or prodrugs the compounds in section (i).

This rejection is traversed.

The present application fully satisfies the written description requirements of Section 112, first paragraph. The present application demonstrates that the inventors had possession, as of the filing date of the application, of the specific subject matter claimed and provides adequate support for the claims.

The specification contains written description for far more than the one species shown in Scheme 1. The scope of the claims with respect to R<sup>3</sup> and R<sup>4</sup> is congruent with the scope of the disclosure for the species disclosed in the specification. The specification at page 35, lines 24 through 25, discloses “[t]he invention also related to physiologically acceptable salts, complexes, solvates or prodrugs of the compounds of the invention.” One skilled in the art, at the time of the invention, would have understood from the written description the resulting physiologically acceptable salts, complexes, solvates, and prodrugs of the compounds of the invention as a further description of the invention, not merely an indication of a result that could be achieved.

The specification at page 36, lines 29 through 30, discloses that “[t]he invention encompasses a compound in amorphous, any polymorphous or any crystalline form.” Again, one skilled in the art, at the time of the invention, would have understood from the written description the invention encompasses a compound in amorphous, any polymorphous or any crystalline form as a further description of the invention, not merely an indication of a result that could be achieved.

The specification details specific embodiments of methods of producing compounds and examples of specific compounds of this invention from page 13 through page 35. The inventors also demonstrated 187 examples. Clearly, the extensive disclosure in the present application, demonstrates the inventors had possession, as of the filing date of the application, of the specific subject matter as claimed by them. An actual reduction to practice

is not necessary as long as the written description enables one of ordinary skill in the art to make and use the invention without undue experimentation.

Respectfully, attention is directed to the Manual of Patent Examining Procedure at Sections 2173.02 and 2173.04:

When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow the claims which define the patentable subject with a reasonable degree of particularity and definiteness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

Breadth of a claim is not to be equated with indefiniteness.

In view thereof, reconsideration and withdrawal of the rejection are requested.

## 2. 35 USC 112, First Paragraph, Enablement Rejection of Claims 1-19 and 45-54

Claims 1-19 and 45-54 are rejected under 35 USC 112, first paragraph, because the Examiner asserts the specification is not enabling for (a) how to use compounds, within the claimed genus, that are not supported by the disclosure, (b) how to make/use crystalline or amorphous forms of the claimed compounds, and (c) how to make/use solvates or prodrugs of the claimed compounds.

The Examiner asserts that concerning (a), because small changes to structure substituents, particularly pointing out R<sup>3</sup> and R<sup>4</sup> of Scheme 1, cause noticeable affects on the binding of the compounds to MCH they will effect modulation activity. The Examiner argues that one of ordinary skill would not expect all of the compounds within the genus elected to possess the claimed activity without guidance in the disclosure. Further, the Examiner asserts that the disclosure provides merely a general suggestion of an idea for (b) and (c) that could be developed into the claimed invention.

The rejection is traversed. The present application fully satisfies the make and use requirements of Section 112, first paragraph. An actual reduction to practice is not necessary

as long as the specification enables one of ordinary skill in the art to make and use the invention without undue experimentation. The argument above is incorporated herein.

The specification details specific embodiments of methods of producing compounds and examples of specific compounds of this invention from page 13 through page 35. The inventors have demonstrated 187 examples. The specification clearly teaches one of skill in the art to make and use more than one compound of the invention. One of skill in the art would be able to easily and without undue experimentation utilize the disclosure and examples to assess the activity of further compounds that fall in the same genus as those disclosed.

One of skill in the art at the time the invention would be familiar with how to make and use crystalline/amorphous/solvated forms of compounds. One of skill in the art would, based on the extensive disclosure of this application and the compounds and examples presented therein, be capable of making and using crystalline/amorphous/solvated forms of the compounds of the invention without undue experimentation.

One of skill in the art at the time the invention was made would be familiar with how to make and use prodrugs of the claimed compounds. One of skill in the art would, based on the extensive disclosure of this application and the compounds and examples presented therein, be capable of making and using prodrugs of the compounds of the invention without undue experimentation.

In view thereof, reconsideration and withdrawal of the rejection are requested.

### 3. 35 USC 112, Second Paragraph Rejections

Claims 1, 9, 11, 12, 13, 18, 19, and 53 are rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, 11, 12, 13, 18, 19, and 53 have been amended. Accordingly, Applicants respectfully request that the rejections be withdrawn.

## CONCLUSION

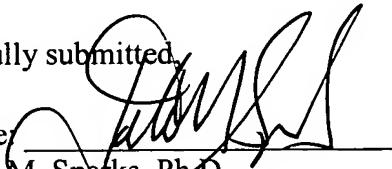
In light of the above remarks, Applicants respectfully request rejoinder of the nonelected inventions and allowance of the subject application.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment to Deposit Account No. **04-1105**.

Dated: December 12, 2007

Respectfully submitted,

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